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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,553	09/22/2000	Paul E. Jacobs	PA000370	2167
23696	7590	04/28/2005	EXAMINER	
Qualcomm Incorporated Patents Department 5775 Morehouse Drive San Diego, CA 92121-1714			ALVAREZ, RAQUEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/668,553

Applicant(s)

JACOBS ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 51-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 51-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 1/27/2005.
2. Claims 1-18 and 51-53 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-18 and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. (5,848,397 hereinafter Marsh) in view of Werkhoven (WO 99/59097 hereinafter Werkhoven).

With respect to claims 1-3, 6-8, 11-18, 51-53 Marsh teaches a method for use on a client device that is configured for communications with at least one remote source of advertisements via a communications network (Abstract). Downloading advertisements from at least one remote source, during one or more advertisements download sessions using an advertisement download function (see figure 4, item 601); storing the downloaded advertisements on a storage medium associated with the client device using an advertisement storage function (col. 14, lines 1-10); effecting display of at least selected ones of the stored advertisements on a display associated with the client device using an advertisement display function (Figure 6, 702).

With respect to an ad obscured ad monitor function that determines whether an obscured ad condition has occurred, whereby the obscured ad condition occurs when an advertisement current being displayed on the display associated with the client device is being obscured by one or more other items currently being displayed on the display and an obscured nag function that generates an obscured ad nag display in response to detection of the obscured ad condition, wherein the obscured nag display notifies the user of the obscured ad condition using an obscured ad nag function while maintaining the one or more current items currently being displayed on the display.

Werkhoven teaches an Internet advertising system, the system monitors if a user opens a window in front of the popup window which has the advertisements, if the system detects that a popup window has been blocked for a predetermined time, then the user is notified of the time limit by returning the pop window to the frontmost position (see page 6, lines 2-5). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the teachings of Werkhoven of ad obscured ad monitor function that determines whether an obscured ad condition has occurred, whereby the obscured ad condition occurs when an advertisement current being displayed on the display associated with the client device is being obscured by one or more other items currently being displayed on the display and an obscured nag function that generates an obscured ad nag display in response to detection of the obscured ad condition, wherein the obscured nag display notifies the user of the obscured ad condition because such a modification would allow to **"determine if the**

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user had closed the window containing the advertisement before the advertisement could complete its presentation” (col. 1, lines 28-30).

With respect to claims 9-10, Marsh further teaches that the software is subsidized by revenues attributable to the downloaded advertisements (col. 3, lines 66-, col. 4, lines 1-6).

Claims 4-5 further recite giving the user a choice of removing whatever is obscuring the advertisement and switching the operating from a first operating mode to a second operating mode, wherein the second operating mode has less features than the first operating mode. The combination of Marsh and Werkhoven teach giving the user a choice of opening a pop window in front of the advertisement displayed and notifying the user that he or she is obscuring the advertisements by removing whatever is obscuring the advertisement (i.e. bringing the advertisement from the background to the foreground)(see rejection above of claims 1-3, 6-8, 11-18 and 51-53). With respect to operating from a first operating mode to a second operating mode, wherein the second operating mode has less features than the first operating mode. Official notice is taken that it is old and well known in the computer related arts to switch from one operating mode to another operating mode that has less features when a problem arises with one of the operating mode because such a modification would allow the software to operate with less features and in that case less problems are less likely to occur. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included as one of the choices switching the operating from a first operating mode to a second operating mode, wherein the second operating

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mode has less features than the first operating mode in order to obtain the above mentioned advantage.

Response to Arguments

4. The amendments to the claims overcame the 101 rejection.
5. The terminal disclaimer has been received and approved. The double patenting rejection has been withdrawn.
6. Applicant argues that Werkhoven doesn't teach providing the users with a choice on what they want to view so that they can continue viewing the items currently displayed on the display. The Examiner respectfully disagrees with Applicant because Werkhoven teaches on page 3, lines 11-15 and lines 33-37 that the users can close the window or multiple windows before viewing the content downloaded to him or her and skipping certain determined portion of the content therefore viewing whatever was currently displayed on the screen. As stated above the users is able to switch from one window to the next and therefore will have control of what he or she wants to view on the display.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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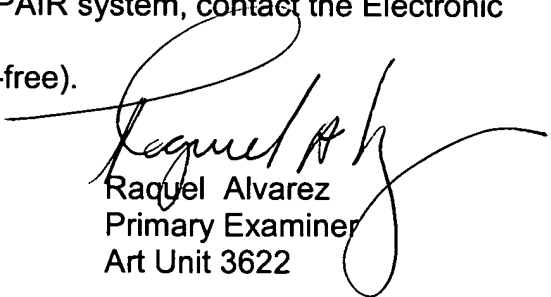
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
4/22/05